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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/973,303	11/28/1997	PETER DORMER	3428-005	6732

21967 7590 03/25/2002

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EXAMINER

CANELLA, KAREN A

ART UNIT	PAPER NUMBER
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1642

DATE MAILED: 03/25/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

08/973,303

Applicant(s)

Dormer

Examiner

Karen Canella

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 months MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_\_
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 36-39, 41, 42, 45-67, and 69-72 is/are pending in the application.
- 4a) Of the above, claim(s) 48-61 and 63-65 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 36-39, 41, 42, 45-47, 62, 66, 67, and 69-72 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some\* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 18) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other \_\_\_\_\_

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***Response to Amendment***

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office Action.
2. Claims 36, 41 and 72 have been amended. Claims 48-61, and 63-65 remain withdrawn from consideration. Claims 36-39, 41, 42, 45-47, 62, 66, 67 and 69-72 are under consideration.
3. The rejection of claims 36-39, 41, 42, 45-47, 62, 66, 67 and 69-72 under 35 U.S.C. 101 because the claimed invention is not supported by either a specific, substantial asserted utility or a well established utility are withdrawn.
4. The rejection of claims 36-39, 41, 42, 45-47, 62, 66, 67 and 69-72 under 35 U.S.C. 112, first paragraph for not being supported by either a asserted utility or a well established utility, is withdrawn.

***Claim Rejections Maintained***

5. The rejection of claims 36-39, 41, 42, 45-47, 62, 66, 67 and 69-72 under 35 U.S.C. 112, first paragraph, for not providing support for variants of the disclosed differentiation-inducing factor is maintained for reasons of record. Applicant argues that the specification fully enables the isolation and screening of the claimed variant fragment and points to pages 18-22 of the specification. However, on examination of those pages, it is notes that they describe only the single differentiation-inducing activity that has been disclosed. The specification provides no guidance as to where to obtain cells that would contain such variants of the differentiation-inducing activity, or if such variants exist, or must be obtained by the expression of synthetic polynucleotide sequences.

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6. Claims 36-39, 45-46, 66 and 69-72 rejected under 35 U.S.C. 102(b) as being anticipated by Dormer et al (Experimental Hematology, 1992, Vol. 20, p. 758). Applicant argues that since Dormer et al does not disclose specific molecular weight range, mRNA expression pattern, cDNA and mRNA encoding said protein, that the reference does not anticipate the claimed product. However, a the protein disclosed by Dormer appears to be the same protein as claimed as it is obtained from the same source and exerts the same functional activity of the claimed protein. Therefore, further characteristics of the claimed protein represent inherent properties of the differentiation-inducing activity.

7. All other rejections and objections as stated in Paper No. 20 are withdrawn.

#### ***Conclusion***

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Karen Canella whose telephone number is (703) 308-8362. The examiner can normally be reached on Monday through Friday from 8:30 am to 6:00 pm. A message may

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be left on the examiner's voice mail service. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony Caputa, can be reached on (703) 308-3995. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Karen A. Canella, Ph.D.  
Patent Examiner, Group 1642  
February 25, 2002

  
SUPERVISOR  
TECHNICAL STAFF